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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,267	04/18/2006	Alain Moussy	065691-0440	4376
22428 7590 08/26/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
SHAMEEM, GOLAM M				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
08/26/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,267

Applicant(s)

MOUSSY ET AL.

Examiner

Golam M. M. Shameem

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16 and 23-28 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 28 is/are rejected.
- 7) ☐ Claim(s) 1-9 and 11-16 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

Claims 1-9, 11-16 and 23-28 are currently pending in the application. Claims 10 and 17-22 were canceled.

Receipt is acknowledged of Applicant's response / amendment filed on June 23, 2009 and that have been entered.

Response to Arguments

Applicant's response and amendments have been fully considered and found partially persuasive with respect to the objection of claims 1-16 and the objection is hereby withdrawn in part. However, upon further consideration, the following new grounds of rejections / objections are made and therefore, Applicants arguments are rendered moot in view of the present Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claim 1 contains the subject matter of a newly introduced proviso, such as ”

provided that N-{2-[2-(3-Acetylamino-phenylamino)-oxazol-5-yl]-benzyl}-2-amino-N-methyl-acetamide and 3-[5-(2-[(2-Amino-acetyl)-methyl-amino]-methyl)-phenyl]-oxazol-2-ylamino]-N-methyl-benzamide are excluded

“

[claim

1 (Currently Amended), lines 15-17, page 6] is considered **a new matter**, since the specification and the originally filed claim 1 excluded this subject matter from the compounds and in the specification on pages 5-10. The amendment changes the scope of the claim 1 to exclude the compound of formula I that was not previously excluded in the invention. Similarly, claim 28 contains the subject matter of a newly introduced claim limitations, such as

“

alkyl¹⁰⁰ group which is an alkyl group defined as a linear, branched or cycloalkyl group containing from 1 to 10 carbon atoms and optionally substituted with one heteroatom such as halogen (selected from F, Cl, Br or I), oxygen, and nitrogen;

”

[Claim 28, lines 6-8, page 22] is considered **a new matter**, since the originally filed specification excluded this subject matter from the compounds as documented in the specification on pages 5-10. The amendment changes the scope of the claim 28 to include the compound of formula I that was not previously included in the invention. This rejection can be overcome by deleting the new matter from the instant claims and also to amend the claims within the context and scope of the claims (limiting with specific type of compounds that actually contemplated in the specification) in order to overcome the rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 and 28 are rejected under 35 U.S.C §102 (c) as being anticipated by Liu *et al* (US 6,596,747). Applicant claims a compound of the formula I [2-Aminoaryloxazole], composition and the methods of use thereof. Liu *et al* also disclose the synthesis of several substituted 2-Aminoaryloxazole compounds and at least one of them anticipates the instantly claimed invention wherein R₁, R₂, R₃, R₄, R₅ and R₆ are all hydrogen, X is NR₉R₁₀, wherein R₉ is hydrogen, R₁₀ is CO-R, wherein R is alkyl and R₇ is a substituted phenyl variant [Liu *et al*, Table 4, columns 54-60, especially example 64], which reads on the instantly claimed compounds.

Response to Election/Restriction

Applicants request to expand the search has been fully considered and found persuasive under MPEP § 803.02 and therefore, the search has expanded to include more and reasonable number of species.

Claims 23-27 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Applicants preserve their right to file a divisional on the non-elected subject matter.

As set forth in the restriction requirement and an election of a single compound (or set of compounds), the scope of the invention which has been examined, inclusive of the elected species is as follows:

A compound of formula (I) as shown in claim 1 wherein:

R1, R2, R3 and R4 are as claimed,

R5 is defined,

R6 is as claimed,

X is as claimed,

R7 is limited to

“

(iv) a heteroaryl¹ group defined as a pyridyl, pyrimidinyl, pyrazinyl, pyridazinyl, thienyl, thiazolyl, imidazolyl, pyrazolyl, pyrrolyl, furanyl, oxazolyl, isoxazolyl, triazolyl, tetrazolyl, indolyl, benzimidazole, quinolinyl group, which may additionally bear any combination, at any one ring position, of one or more substituents such as

halogen (selected from F, Cl, Br or I);

an alkyl¹ group;

a cycloalkyl, aryl or heteroaryl group optionally substituted by a pendant basic nitrogen functionality,

trifluoromethyl, O-alkyl¹ carboxyl, cyano, nitro, formyl, hydroxy, NH- (alkyl¹), alkyl¹, N(alkyl¹)(alkyl¹), and amino, the latter nitrogen substituents optionally in the form of a basic nitrogen functionality;

NHCO-R or NHCOO-R or NHCONH-R or NHSO2-R or NHSO2NH-R or CO-R or COO-R or CONH-R or SO2-R or SO2NH-R wherein R corresponds to hydrogen, alkyl¹

” only and all other variables are defined.

As a result of the election and the corresponding scope of the compound identified, claims 23-27 and the remaining subject matter of claims 1-9, 11-16 and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions.

The withdrawn subject matter of claims 23-27 is properly restricted as it differs materially in structure and in element from the elected subject matter *supra* so as to be patentably distinct there from.

Objections

Claims 1-9, 11-16 and 28 are objected to for containing non-elected subject matter. The claims should be amended to exclude non-elected subject matter and within the scope of elected compound.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 7:30 AM - 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7922. The Official fax phone numbers for this Group are (571) 273-8300. When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet

e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

/Golam M. M. Shameem/
Primary Examiner
Art Unit 1626
Technology Center 1600

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